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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,986	02/09/2001	Michael Brumbaugh	10812/3	2253

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BRINKS HOFER GILSON & LIONE
P.O Box 10395
Chicago, IL 60610

EXAMINER

COHEN, AMY R

ART UNIT PAPER NUMBER

2859

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,986

Applicant(s)

BRUMBAUGH, MICHAEL

Examiner

Amy R Cohen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment and RCE 27 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-29, 33, 37-41, 45 and 48-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-29, 33, 37-41, 45 and 48-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 25-29, 33, 37-41, 45, 48-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over ENC 150 Encoder Mounting Instructions [hereinafter ACU-RITE] in view of Pasek (U. S. Patent No. 3,526,947).

ACU-RITE discloses a method of mounting a position measuring device to a machine tool, comprising: forming holes in a machine tool based on positions of a plurality of mounting holes; aligning said mounting holes of said position measuring device with said holes formed in said machine tool; and attaching said position measuring device to said machine tool (Steps "Saddle Stops" and "Encoder Installation," page 2).

ACU-RITE discloses the method of mounting a position measuring device wherein said position measuring device comprises a linear encoder and wherein attaching said position measuring device comprises inserting screws into said aligned mounting holes of said position measuring device and said holes formed in said machine tool (Step "Encoder Installation," page 3 and "Cross Feed Installation" figure, page 4).

ACU-RITE discloses the method of mounting wherein said machine tool does not move along an axis of travel from the time of positioning to said time of attaching said position measuring device (Step "Encoder Installation," pages 2-3).

ACU-RITE discloses the method of mounting comprising attaching said position measuring device to said reading head bracket prior to said positioning and comprising positioning said reading head bracket against said machine tool; and marking mounting holes of said reading head bracket on said machine tool (Steps "Encoder Installation" and "Reading Head Installation," pages 2-3).

ACU-RITE discloses the method of mounting comprising detaching said position measuring device from said reading head bracket; and attaching said reading head bracket to said machine tool where said mounting holes are located (Steps "Center Support Installation" and "Reading Head Installation," page 3).

ACU-RITE discloses a method of mounting a position measuring device to a machine tool, comprising: a spar that is to support a position measuring device; forming holes in said machine tool based on positions of a plurality of mounting holes in the spar; aligning said mounting holes of said spar with said holes formed in said machine tool; attaching said spar to said machine tool; and attaching said position measuring device to said spar (Steps "Cross Feed Installation" figure, page 4 and "Spar Assembly," page 5-6).

ACU-RITE discloses the method of mounting wherein said attaching of said spar comprises inserting screws into said aligned mounting holes of said position measuring device and said holes formed in said machine tool and wherein said machine tool does not move along an axis of travel from the time of positioning to said time of attaching said spar to said machine tool (Step "Spar Assembly," pages 5-6).

ACU-RITE discloses the method of mounting wherein said attaching of said position measuring device to said machine tool comprises: attaching said position measuring device by

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inserting screws in said holes in said machine tool; and attaching said reading head to said reading head bracket (Step "Leveling screw adjustment" page 3).

ACU-RITE does not disclose a method of mounting comprising a template comprising a plurality of mounting holes wherein the template is not a linear encoder and wherein the template is supported on a machine tool during positioning; attaching a template to the reading head bracket; marking all necessary mounting holes on the machine tool through said plurality of holes of the template; detaching the template from the reading head bracket.

Pasek discloses a method of mounting comprising a template (20) provided with a plurality of markings (24) which are the locations of all of the mounting holes (providing the markings is equivalent to providing the holes since the holes will be made at the markings, Fig. 5), wherein the template is not a linear encoder (Fig. 5); wherein the template is supported on a support during positioning; attaching a template to the member; marking all necessary mounting holes on the support through said plurality of holes of the template; detaching the template from the member; wherein attaching said template to said member comprises aligning said template with said member; wherein attaching said template to said member comprises aligning said template with respect to an axis (Col 1, lines 23-27, Col 2, lines 40-54, Col 9, line 25-Col 12, line 20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of mounting of ACU-RITE to include a template comprising a plurality of mounting holes, wherein the template is not the linear encoder and wherein the template is supported by the machine tool and wherein the template is attached and detached from the reading head bracket, as taught by Pasek, so that a user could save time when installing

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a linear encoder by using a template which has a plurality of mounting holes and so that a user could install a liner encoder without having to maneuver the linear encoder several times before permanent installation on a machine tool and since the problem of mounting a device to a support using a template attached to and removed from both objects is already suggested by Pasek (Col 1, lines 23-27 and Col 2, lines 40-54).

Response to Arguments

3. Applicant's arguments, see Amendment and RCE, filed 27 October 2003, with respect to the rejection(s) of claim(s) 25-37 and 37-45 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of ENC 150 Encoder Mounting Instructions [hereinafter ACU-RITE] in view of Pasek (U. S. Patent No. 3,526,947).

4. In response to applicant's argument that Nygren is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the rejection in view of Nygren has been withdrawn and the new rejection of ACU-RITE in view of Pasek has been used. The Pasek reference discloses the use of a template, which is to be mounted to both the support and the member to be mounted in order to mark all appropriate mounting marks and removing the template from the support and member prior to attaching the member. Since the Pasek reference

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solves the particular problem with which the applicant is concerned, it is therefore considered analogous art.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R Cohen whose telephone number is (703) 305-4972. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on (703) 308-3875. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

ARC
December 18, 2003


G. BRADLEY BENNETT
PRIMARY EXAMINER

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~~Diego Gutierrez~~
~~Supervisory Examiner~~
~~Tech Center 2800~~